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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,448	11/21/2001	Adrian Velthuis	08011.3012-00	1416
22852	7590	10/07/2005	EXAMINER	
		FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413	CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/989,448

Applicant(s)

VELTHUIS ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 7/20/05.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 7/20/05.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1, 3, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al (US6385591) in view of DeLuca et al (US5870030).**

Regarding claims 1, 3, 9, 11, Mankoff et al teaches the concept of a user browsing webpages on the Internet and clicking a banner advertisement to request an electronic coupon be delivered (from a coupon server) to his computer. Mankoff et al teaches that the coupon can be redeemed at a retailer by synchronizing (connecting) the computer to the retailer computer and transferring the coupon to the retailer. It is not clear to what extent the coupon to be redeemed is displayed to a retailer, however the examiner is relying on DeLuca et al for such display (to then redeem). DeLuca et al teaches electronic coupons that are stored in a portable device. DeLuca et al teaches that the portable coupon device may display a text coupon or barcode coupon in order for a retailer clerk to visually redeem the coupon – by way of optically scanning or by simple visual inspection [col 10 lines 55+]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the electronic coupons of

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Mankoff et al on the portable device in order to allow redemption by scanning or by simple inspection as a simple additional or alternative redemption method. This would provide an easier to implement redemption method; no particular hardware compatibility between the POS and the PDA or portable device would be required to redeem the coupon. The display of a text coupon is taken to be display of a subset of the coupon data (i.e. barcode data is not displayed) to accommodate a text-only display.

4. Claims 2, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view of DeLuca et al and Golden et al (US5761644B). Mankoff et al does not teach limiting the number of coupons to be downloaded to the user device.

Golden et al also teaches downloading electronic coupons to a user computer. Golden et al provides a feature whereby the user may download only a certain number of coupons [col 4 lines 2-8]. It would have been obvious to one of ordinary skill at the time of the invention to have enabled such a provision of a predetermined maximum number of coupons that can be downloaded to the user's device. Such a feature would help prevent coupon fraud, for example.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view Sim (KR2000030358A). Sim (KR2000030358A) is a document that was published June 5, 2000. The WO 01/63507 A1 document has been included merely as an English-language equivalent of Sim (KR2000030358A) and will be used to reference portions of Sim's disclosure which support the examiner's conclusions.

Regarding claims 4, 5, Mankoff et al teaches delivery of electronic coupons to user devices such as PDA's, smart watches Internet appliances and other devices [col 3 lines 35-39]. Mankoff et al does not teach delivery to wireless phones. Sim (KR2000030358A) teaches delivery of electronic coupons to wireless phone users [pg 3] and it would have been obvious to one of ordinary skill at the time of the invention to have delivered the coupons of Mankoff et al to user's phones as an alternative portable coupon device. Sim (KR2000030358A) teaches that a database is provided on coupon server 6 which stored user's phone numbers so that coupons can be delivered to a particular identified user phone. It would have been obvious to one of ordinary skill at the time of the invention for the user to have inputted/provided his wireless phone number (or other wireless identifier) to the system so that his phone can be correctly identified in the database responsible for delivering the coupons. Mankoff et al teaches that the site that provides the coupon-associated advertising may be a different server than the one which ultimately delivers the coupon to the identified user [col 2 lines 7-20, col 3 lines 50 to col 4 line 12, FIG 4]. The coupon is taken to be a purchasing incentive.

Regarding claim 6 as best understood, Mankoff et al teaches that it is well known to receive electronic coupons and print them [col 1 lines 28-35].

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view Sim (KR2000030358A) and DeLuca et al. Sim (KR2000030358A) is a document that was published June 5, 2000. The WO 01/63507 A1 document has been included merely as an English-language equivalent of Sim

(KR2000030358A) and will be used to reference portions of Sim's disclosure which support the examiner's conclusions.

Regarding claims 7, 8, It is not clear to what extent Mankoff et al's coupon to be redeemed is displayed to a retailer, however the examiner is relying on DeLuca et al for such display (to then redeem). DeLuca et al teaches electronic coupons that are stored in a portable device. DeLuca et al teaches that the portable coupon device may display a text coupon or barcode coupon in order for a retailer clerk to visually redeem the coupon – by way of optically scanning or by simple visual inspection [col 10 lines 55+]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the electronic coupons of Mankoff et al on the portable phone device of Sim (KR2000030358A) in order to allow redemption by scanning or by simple inspection.

Response to Arguments

Applicant's arguments filed 7/20/05 have been fully considered but they are not persuasive. Applicant argues that Mankoff does not "lend itself to combination" with DeLuca. Examiner disagrees and repeats the motivation stated above. "It would have been obvious to one of ordinary skill at the time of the invention to have displayed the electronic coupons of Mankoff et al on the portable device in order to allow redemption by simple inspection as a simple alternative or additional redemption method. This would provide an easier to implement redemption method; no particular hardware compatibility between the POS and the PDA or portable device would be required to redeem the coupon."

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Applicant appears to argue that certain element(s) of claim 4 have not been properly addressed. Applicant has noted one component of the associated rejection - a statement that Mankoff's coupon is taken to be a "purchasing incentive," but offers no guidance regarding where or how the balance of the provided rejection is flawed, nor any particular claim language left unaddressed by the examiner's combination. Reciting the claim language in its entirety provides no further guidance.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc